

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant	Lars Severinsson
Serial No. 09/710,962	Filing Date: November 10, 2000
Title of Application	Disc Brake Caliper
Group Art Unit 3683	Examiner: Schwartz, Christopher P

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Appeal Brief Under 37 CFR §41.37

Dear Sir:

A Notice of Appeal from the final rejection of Claims 29-32, all pending claims of U.S. Patent Application No. 09/710,962, being filed herewith, Appellant accordingly files its Appeal Brief in connection with its appeal. A Claims Appendix is submitted herewith, as are Appendices related to evidence previously submitted and decisions related to the case.

(i) Real Party In Interest

The real party in interest is Haldex Brake Products AB of Landskrona, Sweden, assignee of the present patent application.

(ii) Related Appeals and Interferences

There are no related Appeals or Interferences.

(iii) Status Of Claims

Claims 1-28 have been cancelled. Claims 29-32 stand rejected and are the subject of the instant Appeal. A copy of each of these claims is attached hereto in the Claims Appendix.

(iv) Status Of Amendments

No Amendments have been filed since the outstanding Final Office Action was mailed on September 14, 2007.

(v) Summary Of Claimed Subject Matter

Claim 29 is the rejected independent claim and is discussed below.

Independent Claim 29

Claim 29 is directed to a disc brake caliper system with a disc brake caliper including a housing (1) to be arranged astraddle of a vehicle brake disc, two thrust sleeves (8), which are connected to a brake pad holder (6) provided with a brake pad (5) for braking engagement with the brake disc and which are axially movable in the housing at a distance from each other, a cross bar (9) connecting the two thrust sleeves (8), and a lever (17) for transmitting a brake force from a brake cylinder (4) attached to the disc brake caliper, to the cross bar (9). See, e.g., U.S. Patent No. 5,833,035 at column 2, line 66 – column 3, line 22; column 3, lines 44 - 53; Figs. 1, 2. A mechanism including at least the thrust sleeves (8), the cross bar (9) and the lever (17) is held together as a unit in the absence of the housing (1). See, e.g., U.S. Patent No. 5,833,035 at column 2, lines 28-32; column 3, lines 30-36; Figs. 1, 2. Bearing tappets (20), parallel with the cross bar (9), are fixedly connected to the inside of the disc brake caliper. See, e.g., U.S. Patent No. 5,833,035 at column 1, lines 27-30; column 3, lines 51-54; Figs. 1, 2. The lever (17), besides an arm (18) for actuation by the brake cylinder (4), includes a curved wedge (19), having an inner cylindrical surface (19') in engagement with outer cylindrical surfaces of the bearing tappets (20) and an outer cylindrical surface (19") -- with greater radius than the inner cylindrical surface (19') -- in engagement with an inner cylindrical surface of the cross bar (9). See, e.g., U.S. Patent No. 5,833,035 at column 3, line 44 - column 4, line18; Figs. 1, 2, 3, 4.

(vi) Grounds Of Rejection To Be Reviewed On Appeal

Claims 29-32 stand rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

(vii) Argument

Rejection of Claims 29-32 under 35 U.S.C. 251

In an Office Action mailed on February 15, 2000 during prosecution of the parent to the present application, 08/817769 (now RE37231), Examiner Christopher P. Schwartz rejected amended claim 16 of the parent application, which is similar in material respects to claim 29 of the present application, under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,433,298 to Antony et al. Appellant filed a Response on April 12, 2000, requesting that the Examiner reconsider his position and highlighting the novel aspects of the invention over the cited prior art. Thereafter, Examiner Schwartz telephoned the undersigned, to inform him that although Examiner Schwartz had determined that Claim 16 was patentable over the references of record, and had attempted to issue a Notice of Allowability, a reissue supervisor at the U.S. Patent Office had instructed Examiner Schwartz not to issue the Notice of Allowability, and instead reject Claim 16 under the theory of impermissible recapture. In response to

this telephone conversation, Appellant amended Claim 16 to remove any question of recapture so as not to delay the issuance of the parent application. Appellant filed the present application, with Claim 29 of the present application being similar in material respects to Claim 16 of the parent case before having been amended to remove any question of recapture.

For the foregoing reasons, Appellant respectfully submits that any questions of patentability with respect to the prior art have already been resolved, and that the only outstanding issue presented in this Appeal relates to the recapture allegation.

Pursuant to 35 U.S.C. § 251, a patentee may obtain reissue of a patent if the patent is, through error “without any deceptive intention, deemed wholly or partly inoperative or invalid, . . . by reason of the patentee claiming more or less than he had a right to claim in the patent” 35 U.S.C. § 251; see also 37 C.F.R. § 1.175. In considering the ‘error’ requirement, it must be kept in mind that “the reissue statute is ‘based on fundamental principles of equity and fairness, and should be construed liberally.’” *Medtronic, Inc. v. Guidant Corporation*, 465 F.3d 1360, 80 USPQ2d 1558, 1556 (Fed. Cir. 2006) (quoting *Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1479, 46 USPQ2d 1641, 1647 (Fed. Cir. 1998)). Of course, Applicant acknowledges that reissue proceedings, however, cannot be used to obtain subject matter that could not

have been included in the original patent. Under the “recapture” rule, the deliberate surrender of a claim to certain subject matter during the original prosecution of the application for a patent “made in an effort to overcome a prior art rejection” is not such “error” as will allow the patentee to recapture that subject matter in a reissue. *In re Clement*, 131 F.3d 1464, 1468-69, 45 USPQ2d 1161, 1164 (Fed. Cir. 1997). Thus, the recapture rule prevents a patentee from regaining, through reissue, subject matter that was surrendered during prosecution of the original patent in an effort to obtain allowance of the original claims.

Of course, Applicant recognizes that a surrender can occur by argument as well as by amendment. *Hester*, 142 F.3d at 1480-84, 46 USPQ2d at 1647 (noting the statement in *Clement* that “[t]o determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection” (quoting *Clement*, 131 F.3d at 1469, 45 USPQ2d at 1164)). In this regard, the Federal Circuit stated in *Hester* that, like prosecution history estoppel, “unmistakable assertions made to the Patent Office in support of patentability” “can give rise to a surrender for purposes of the recapture rule.” *Hester*, 142 F.3d at 1482, 46 USPQ2d at 1649 (emphasis added). The fact that “unmistakable assertions”, as opposed to incidental statements, are necessary to give rise to a recapture, particularly in view of the equitable nature of reissue applications,

was again unequivocally and repeatedly recognized by the Federal Circuit in *Medtronic*, in which the court stated, for example, in two separate instances “Thus, Mr. Nikolai did not clearly and unmistakably surrender the unconditional embodiment.” *Medtronic*, 465 F.3d 1360, 80 USPQ2d at 1569 (emphasis added). In even more clearly distinguishing incidental statements made during prosecution from “clear and unmistakable” surrender of subject matter the court in *Medtronic* also stated:

We do not think Mr. Nikolai’s statements about Nappholz’s single ventricular sensing electrode (which were made in the context of distinguishing Nappholz from Dr. Mower’s conditional embodiment) are unmistakable assertions in support of patentability distinguishing it from the embodiment with only one sensing electrode. That is because the statements were not made in the context of distinguishing Nappholz and the claimed invention based on the number of sensing electrodes, but rather in the context of distinguishing Nappholz from the conditional embodiment. In other words, we cannot say that the statement was an unmistakable assertion in support of patentability that invalidates the reissue patent claims covering the embodiment with only one sensing electrode.

Medtronic, 465 F.3d 1360, 80 USPQ2d at 1570 (emphasis added).

In determining whether impermissible recapture exists, the Federal Circuit has recognized a three-part test: “We apply the recapture rule as a three-step process: (1) first, we determine whether, and in what respect, the reissue claims are broader in scope than the original patent claims; (2) next, we determine whether the broader aspects of the reissue claims relate to subject matter surrendered in the original prosecution; and (3) finally, we determine whether the reissue claims were materially narrowed in other respects, so that the claims may not have been enlarged, and hence

avoid the recapture rule.” *Medtronic*, 465 F.3d 1360, 80 USPQ2d at 1566 (*quoting N. Am. Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 1349, 75 USPQ2d 1545, 1556 (Fed. Cir. 2005)).

In the present application, the Examiner has asserted that the current claims are broader in that the present reissue claims do not require a cover. Appellant agrees with the Examiner on this point.

Thus, it becomes necessary to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an Appellant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.” *In re Clement*, 131 F.3d 1464, 1468-69 (Fed. Cir. 1997) citing *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 995-96 (Fed. Cir. 1993).

Appellant respectfully suggests that the cover does not relate to surrendered subject matter, as the cover itself was not added and no arguments about the presence of the cover itself were made in an effort to overcome a prior art rejection.

Appellant notes the Examiner's citation of the specification, page 2, line 29: "...but the cover and the rest of the mechanism are also **held together as a unit...**". Appellant also notes the Examiner's citation of page 6 of Appellant's remarks in the original parent case 08/817769 (now RE37231): "Parent claim 1 is amended to better structurally define Applicant's novel feature wherein the housing and cover members are structured with the entire braking unit carried by the cover independently from the housing to be inserted as a unit." The Examiner has apparently construed these statements to mean that a cover is required as part of the novelty of the invention. Appellant respectfully disagrees.

As the Examiner has himself noticed (as indicated by his highlighting of the phrase in the quoted portion of the specification), the novelty of the invention is that the brake mechanism is "held together as a unit." Similarly, Appellant suggests that the relevant phrase of the quoted portion of Appellant's remarks in the original parent case 08/817769 (now RE37231) is as follows: that the braking unit be separate "from the housing to be inserted as a unit". This interpretation is supported by a reading of Appellants arguments as a whole for patentability in its previous responses to office actions. Appellant consistently argued for patentability on the basis that the brake mechanism be held together as a unit.

The presence of the cover itself was never asserted to contribute to patentability, and indeed it could not have been since the prior art clearly disclosed a brake system having a housing and a cover (see for example U.S. Patent No. 5,927,445 to Bieker, which was brought to the Examiner's attention in the present application via an IDS). Thus, it was Appellant's assertion that a preassembled brake mechanism held together as a unit was patentable. That the preassembled brake mechanism must include a cover was not argued as making the invention patentable, and indeed was not what made the invention patentable. As such, removal of the cover in the present application does not constitute impermissible recapture, as the cover does not relate to surrendered subject matter. If the cover was present, it would form part of the preassembled brake mechanism -- however, there was no argument made that the cover itself was required for novelty or somehow distinguished over the prior art.

Appellant respectfully submits that the situation presented here is very similar to the one facing the Federal Circuit in *Medtronic*. Like the applicant in *Medtronic*, the present Applicant's statements made during prosecution concerning the cover were merely incidental. The prior art was not being distinguished based on the presence of the cover, but rather on the basis of a preassembled brake mechanism held together as a unit. Thus, the cover, although clearly present in the claims of the original patent, was neither added in an effort to overcome prior art nor argued to distinguish the claims from

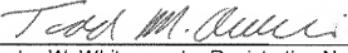
basis of the presence of a cover, nor can it be said that Applicant "clearly and unmistakably surrender[ed]" the embodiments of the invention that do not require a cover.

Moreover, it should again be noted that the Examiner has already expressed that claims directed to the wedge configuration are patentable over the prior art without the inclusion of a cover.

Conclusion

Appellant has made a significant advance over the prior art by providing a less complex, less expensive and more reliable disc brake caliper than has heretofore been known. Accordingly, reconsideration and allowance of all pending claims is believed in order, and such action is earnestly solicited.

Respectfully submitted,


Wesley W. Whitmyer, Jr., Registration No. 33,558
Todd M. Oberdick, Registration No. 44,268
Attorneys for Appellant
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155

Attorneys for Appellant

**Claims Appendix
to Appeal Brief Under 37 CFR §41.37
Serial No. 09/710,962**

29. A disc brake caliper system comprising a disc brake caliper including a housing (1) to be arranged astraddle of a vehicle brake disc, two thrust sleeves (8), which are connected to a brake pad holder (6) provided with a brake pad (5) for braking engagement with the brake disc and which are axially movable in the housing at a distance from each other, a cross bar (9) connecting the two thrust sleeves, and a lever (17) for transmitting a brake force from a brake cylinder (4) attached to the disc brake caliper, to the cross bar, characterized in that a mechanism including at least the thrust sleeves (8), the cross bar (9) and the lever (17) is held together as a unit in the absence of the housing (1) and further characterized in that bearing tappets (20), parallel with the cross bar (9), are fixedly connected to the inside of the disc brake caliper and in that the lever (17), besides an arm (18) for actuation by the brake cylinder (4), comprises a curved wedge (19), having an inner cylindrical surface (19') in engagement with outer cylindrical surfaces of the bearing tappets and an outer cylindrical surface (19") -- with greater radius than the inner cylindrical surface -- in engagement with an inner cylindrical surface of the cross bar.

30. A mechanism according to Claim 29, characterized in that an adjuster mechanism (28) is arranged on a splined shaft (29) rotatably journaled in the bearing tappets (20).

31. A mechanism according to Claim 30, characterized in that the adjuster mechanism (28) is arranged between the two bearing tappets (20).

32. A mechanism according to Claim 31, characterized in that an adjuster housing (33) of the adjuster mechanism (28) is provided with external gears in engagement with a gear wheel (41) rotatably journaled in the housing (1), the gear wheel (41) in turn being in engagement with an internal gear segment (17") in an arcuate yoke (17') of the lever (17).

Appeal Brief Under 37 C.F.R. §41.37

Serial No. 09/710,962

Page 14

**Evidence Appendix
to Appeal Brief Under 37 CFR §41.37
Serial No. 09/710,962**

No evidence of any kind, including evidence submitted under 37 CFR 1.130, 1.131 or 1.132, has been entered by the Examiner and relied upon by Appellant in the appeal.

Appeal Brief Under 37 C.F.R. §41.37

Serial No. 09/710,962

Page 15

**Related Proceedings Appendix
to Appeal Brief Under 37 CFR §41.37
Serial No. 09/710,962**

There are no related Appeals or Interferences. As such, there are no decisions rendered by a court or the Board in any such Appeals or Interferences.